

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Michel SERPELLONI

Conf. 9/08

Application No. 10/534,038

Group 1615

Filed May 6, 2005

Examiner A. Sasan

USE OF BRANCHED MALTO-DEXTRINS AS GRANULATION BINDERS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 14, 2010

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

A Notice of Appeal is filed herewith.

The review is requested for the reasons advanced on the attached sheets.

Respectfully submitted,

YOUNG & THOMPSON

/Robert A. Madsen/

Robert A. Madsen, Reg. No. 58,543
209 Madison Street, Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

RAM/fb

REASONS IN SUPPORT OF REQUEST FOR REVIEW

A pre-appeal brief review is respectfully requested because the two grounds of rejection included at least one clear factual error and one a clear legal error, as explained below.

I. Claims 10-12, 16-19, 23-26 and 29-30 were not obvious over ONO et al. U.S. 5,080,908 ("ONO") in view of FOUACHE et al. US 6,630,586 B1 ("FOUACHE").

A. Factual Error.

In the motivation statement, the Examiner correctly identified expected properties from branched maltodextrins as disclosed by FOUACHE at the top of page 4 of the Office Action is (Emphasis added):

"One of ordinary skill in the art would substitute the maltodextrin of Ono with the branched maltodextrin of Fouache with a reasonable expectation of success in producing a functional product with the nutritional advantages of including an indigestible dietary fiber and having an acariogenic composition."

However, the Examiner incorrectly concluded in the next paragraph that "the combination of references will lead to the expected result of obtaining a homogeneous granular product."

That is, this conclusion is a factual error.

Neither ONO nor FOUACHE suggests an improvement, or an advantage, in terms of granulation properties, by using branched maltodextrins. Indeed, neither document discusses the effect of starch on the granulation properties.

As disclosed in present specification states and as demonstrated in the declaration of Philippe Lefevre filed May 13, 2009, an advantage of the claimed branch maltodextrins is an improved granulation.

Thus, this advantage is an unexpected result in light of ONO and FOUACHE.

B. Legal Error.

The position held by the Examiner, regarding the Declaration beginning in the last paragraph of page 4 follows (Emphasis added):

Since one of ordinary skill in the art would find it obvious to use the method of preparing granules with a branched maltodextrin in place of the dextrin taught by Ono, and since Ono teaches the desirability of the uniform distribution of the active ingredient (Col. 3, lines 4-9), the combination of references will lead to the expected result of obtaining a homogeneous granular product.

The comparison provided by the declarant is therefore, neither surprising nor unexpected. Rather, the combination of Ono and Fouache will lead one of ordinary skill in the art to have a reasonable expectation of success of producing a functional granular, product with homogeneously or uniformly distributed active ingredient.

This position included a legal error, e.g., in view of MPEP 716.02(e), which states:

Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring) (Evidence rebutted *prima facie* case by comparing claimed invention with the most relevant

prior art. Note that the majority held the Office failed to establish a *prima facie* case of obviousness.); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 "would be requiring comparison of the results of the invention with the results of the invention." 357 F.2d at 422, 148 USPQ at 714.). Emphasis added.

Thus, the position of the Examiner was erroneously based on "requiring comparison of the results of the invention with the results of the invention".

C. Conclusion

In view of these errors, and the fact that the declaration shows the surprising and unexpected properties of the claimed branched maltodextrins, the claimed invention is unobvious over ONO in view of FOUACHE.

Therefore, the rejection should be withdrawn.

II. Claims 10, 13-16, 20, 24, 27-28 and 30 were not obvious by OLINGER et al. U.S. 5,240,115 ("OLINGER") in view of FOUACHE et al. US 6,630,586 B1 ("FOUACHE").

The Examiner proposed substituting the branched maltodextrins of FOUACHE for the hydrogenated starch hydrolysate in the xylitol granulate of OLINGER due to the advantages of the branched maltodextrins, i.e., to obtain a product having an indigestible dietary fiber and acariogenic composition.

A. Factual error.

The motivation suggests that OLINGER fails to teach an indigestible dietary fiber and acariogenic composition.

This is a factual error.

OLINGER already teaches a non-cariogenic composition (Abstract) using non-digestible dietary fibers as binders, i.e., polydextrose, alkali carboxy-methylcellulose, and the hydrogenated starch hydrolysate. These particular binders are the preferred binders, as other binders may be detrimental to the composition, i.e., impairing or eliminating taste. (See, e.g., column 5, lines 23-62).

B. Legal error.

The cited documents do not recognize branched maltodextrins (or standard maltodextrins) as being equivalent to polydextrose, alkali carboxy-methylcellulose, and the hydrogenated starch hydrolysate for the purpose of binding a granulate.

FOUACHE teaches branched maltodextrins, but not for use as binders for granulates.

Moreover, in light of the failings of other binders, as disclosed in OLINGER, there would have been no expectation of success (as discussed above).

Thus, based on these teachings, or lack thereof, in the cited documents, there is no suggestion of branched

maltodextrins offering an advantage over or being equivalent to the binders of OLINGER.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless ****>**the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Indeed, the results obtained by the claimed invention were not predictable by one of ordinary skill in the art.

As explained in the present specification on page 13, lines 1-4 and in Example 1 on pages 17-18, the claimed branched maltodextrins are far more viscous in solution than conventional soluble fibers, including polydextrose. This would have suggested to one of ordinary skill in the art that the higher viscosity would not naturally be intended for use as granulation binders (per the discussion under Table 1).

As evidenced by the Declaration, the claimed branched maltodextrins are good binders for granulations.

C. Conclusion

In view of these errors, and the fact that the declaration shows the surprising and unexpected properties of the claimed branched maltodextrins, the claimed invention is unobvious over OLINGER in view of FOUACHE.

Therefore, the rejection should be withdrawn.